



I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 743886683 US, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: March 24, 2006

Signature:

(Norman Green)

Docket No.: 564462000820 /  
D1180-2US  
(PATENT)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Dan E. ROBERTSON et al.

Confirmation No.: 8980

Application No.: 09/903,410

Art Unit: 1652

Filed: July 10, 2001

Examiner: Rebecca E. Prouty

For: ENZYMES HAVING ESTERASE ACTIVITY  
AND METHODS OF USE THEREOF

### **RENEWED PETITION TO ACCEPT UNINTENTIONALLY DELAYED CLAIM FOR PRIORITY UNDER 35 U.S.C. § 365(c)**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the DECISION ON PETITION (the "DECISION", copy attached) mailed May 28, 2004, received in connection with the subject application, from the OFFICE OF PETITIONS, dismissing Applicants' Petition submitted May 13, 2004, Applicants hereby renew their petition for entry of the enclosed amendment claiming benefit under 35 U.S.C. § 365(c) of International Application No. PCT/US97/02039, filed February 11, 1997 and published as WO 97/30160. The present application is directed to enzymes having esterase activity and methods of use thereof; aspects of this were described in International Application No. PCT/US97/02039. The applications contain at least one inventor in common and the PCT application discloses the invention claimed herein.

Applicants hereby state that the entire delay between the date the claim for benefit was due under 37 C.F.R. § 1.78(a)(5) and the date of the prior petition was unintentional.

Applicants therefore submit concurrently herewith a Substitute Amendment in compliance with the stated requirement of the DECISION. Entry of the Substitute Amendment and accordation of benefit are respectfully requested.

Applicants also submit concurrently a copy of Supplemental Application Data Sheet as filed with the prior Petition on May 13, 2004 which now properly compares with the amended Specification.

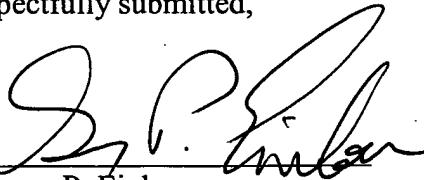
Applicants also request that an Updated Filing Receipt be issued containing the amendment to the Specification in the Substitute Amendment under the heading:  
**"Domestic Priority data as claimed by applicant"**

No fee is believed to be due for this Renewed Petition, as the required fee was submitted with the previous Petition.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket No. 564462000820.

Dated: March 24, 2006

Respectfully submitted,

By   
Gregory P. Einhorn

Registration No.: 38,440  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive, Suite 100  
San Diego CA 92130-2040  
direct dial 858 720 5133  
general office 858 720 5100  
fax direct 858 523 5933  
fax office 858 720 5125  
Email geinhorn@mofo.com



UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

JUN 02 2004

MORRISON & FOERSTER  
SAN DIEGO

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

COPY

MORRISON & FOERSTER LLP  
3811 VALLEY CENTER DRIVE  
SUITE 500  
SAN DIEGO CA 92130-2332

* No Docketing Required *	
Reviewing by Docketing	
Initials	CTS

COPY MAILED

MAY 28 2004

OFFICE OF PETITIONS

: DECISION ON PETITION  
: UNDER 37 CFR 1.78(a)(3)

In re Application of  
Dan E. Robertson et al  
Application No. 09/903,410  
Filed: July 10, 2001  
Attorney Docket No. 564462000820

This is a decision on the petition under 37 CFR 1.78(a)(3), filed May 17, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to the prior-filed PCT application set forth in the amendment filed concurrently with the instant petition.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above.

A reference to add the above-noted, prior-filed application on page one following the first sentence of the specification has been included in a concurrently filed amendment. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew a distinction between a permissible 35

COPY

U.S.C. § 120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The court specifically stated:

Section 120 merely provides a mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. See In re deSeversky, supra. Note also MPEP 201.06(c).

Additionally, the amendment filed with the instant petition do not compare with the application data sheet. It is not clear in the amendment what application is the PCT a continuation of, and the relationship of Application No. 09/382,242, to the instant application is not stated.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment<sup>1</sup> deleting the incorporation by reference statement to the prior-filed PCT application and correcting the above matter along with a renewed petition under 37 CFR 1.78(a)(3), is required.

As authorized, the \$1330 fee required by 37 CFR 1.78(a)(3)(ii) will be charged to petitioner's Deposit Account No. 03-1952.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                    Mail Stop PETITIONS  
                                  Commissioner for Patents  
                                  Post Office Box 1450  
                                  Alexandria, VA 22313-1450

COPY

---

<sup>1</sup> Note 37 CFR 1.121

By hand: Customer Window located at:

2011 South Clark Place  
Crystal Plaza Two Lobby  
Room 1B03  
Arlington, VA 22202

By fax: (703) 872-9306  
ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8859.

*Karen Creasy*

Karen Creasy  
Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

COPY



## Supplemental Application Data Sheet

### **Application Information**

Application number:: 09/903,410  
Filing Date:: 07/10/01  
Application Type:: Regular  
Subject Matter:: Utility  
Suggested Group Art Unit:: 1652  
CD-ROM or CD-R?:: None  
Sequence submission?:: None  
Computer Readable Form (CRF)?:: No  
Title:: ENZYME HAVING ESTERASE ACTIVITY  
AND METHODS OF USE  
Attorney Docket Number:: 564462000820  
Request for Early Publication?:: No  
Request for Non-Publication?:: No  
Small Entity?:: No  
Petition included?:: Yes  
Secrecy Order in Parent Appl.?:: No

### **Applicant Information**

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: Dan  
Middle Name:: E.  
Family Name:: ROBERTSON  
City of Residence:: Solana Beach  
State or Province of Residence:: CA  
Country of Residence:: US  
Street of mailing address:: 818 Viva Court  
City of mailing address:: Solana Beach

COPY

State or Province of mailing address:: CA  
Postal or Zip Code of mailing address:: 92075

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: Dennis  
Family Name:: MURPHY  
City of Residence:: Malvern  
State or Province of Residence:: PA  
Country of Residence:: US  
Street of mailing address:: 1320 Eaves Spring Road  
City of mailing address:: Malvern  
State or Province of mailing address:: PA  
Postal or Zip Code of mailing address:: 19355

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: John  
Family Name:: REID  
City of Residence:: Ardmore  
State or Province of Residence:: PA  
Country of Residence:: US  
Street of mailing address:: 44 St. Pauls Road  
City of mailing address:: Ardmore  
State or Province of mailing address:: PA

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: Anthony

COPY

Family Name:: MAFFIA  
City of Residence:: Wilmington  
Country of Residence:: DE  
Street of mailing address:: 6-A Old Matawan Road  
City of mailing address:: Old Bridge  
State or Province of mailing address:: NJ  
Postal or Zip Code of mailing address:: 08857

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: Steven  
Family Name:: LINK  
City of Residence:: Wilmington  
State or Province of Residence:: DE  
Country of Residence:: US  
Street of mailing address:: 108 Gibson Avenue  
City of mailing address:: Wilmington  
State or Province of mailing address:: DE  
Postal or Zip Code of mailing address:: 19803

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: Ronald  
Middle Name:: V.  
Family Name:: SWANSON  
City of Residence:: Del Mar  
State or Province of Residence:: CA  
Country of Residence:: US  
Street of mailing address:: 13304 Barbados Way  
City of mailing address:: Del Mar

COPY

State or Province of mailing address:: CA  
Postal or Zip Code of mailing address:: 92014

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: Patrick  
Middle Name:: V.  
Family Name:: WARREN  
City of Residence:: Coatesville  
State or Province of Residence:: PA  
Country of Residence:: US  
Street of mailing address:: 117 Brandywine Dr.  
City of mailing address:: Coatesville  
State or Province of mailing address:: PA  
Postal or Zip Code of mailing address:: 19320

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: Anna  
Family Name:: LENOX (formerly KOSMATKA)  
City of Residence:: Perkiomenville  
State or Province of Residence:: PA  
Country of Residence:: US  
Street of mailing address:: 940 Henning Rd.  
City of mailing address:: Perkiomenville  
State or Province of mailing address:: PA  
Postal or Zip Code of mailing address:: 18074

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: US

COPY

Status:: Full Capacity  
Given Name:: Jay  
Middle Name:: M.  
Family Name:: SHORT  
City of Residence:: Rancho Santa Fe  
State or Province of Residence:: CA  
Country of Residence:: US  
Street of mailing address:: 6801Paseo Delicias, Box 7214  
City of mailing address:: Rancho Santa Fe  
State or Province of mailing address:: CA  
Postal or Zip Code of mailing address:: 92067-7214

Applicant Authority Type:: Inventor  
Primary Citizenship Country:: US  
Status:: Full Capacity  
Given Name:: Eric  
Middle Name:: J.  
Family Name:: MATHUR  
City of Residence:: Carlsbad  
State or Province of Residence:: CA  
Country of Residence:: US  
Street of mailing address:: 2654 Galicia Way  
City of mailing address:: Carlsbad  
State or Province of mailing address:: CA  
Postal or Zip Code of mailing address:: 92009

#### **Correspondence Information**

Correspondence Customer Number:: 25225

#### **Representative Information**

Representative Customer Number:: 25225

COPY

### **Domestic Priority Information**

Application::	Continuity Type::	Parent Application::	Parent Filing Date::
This Application	Continuation-in-part of	09/382,242	08/24/99
09/382,242	Continuation of	08/602,359	02/16/96
09/382,242	Continuation of	PCT/US97/02039	02/11/97

**COPY**